

## REMARKS

Claims 58-81 are pending in this application.

Claim(s) 58, 69 and 80 are independent.

The Examiner notes that the substitute specification filed on July 23, 2001, has not been entered. The non-entry is respectfully traversed.

On further consideration, it appears that there has been and remains some confusion regarding the substitute specification.

The substitute specification has been filed at the request of the USPTO to correct a minor informality, i.e. improper margins in the originally filed application. That is, the substitute specification was filed to better arrange the papers for printing and copying (see the Notice to File Missing Parts of Nonprovisional Application, dated June 4, 2001). Hence, the substitute specification is submitted under 37 CFR §1.125(a) (not §1.125(b)). Thus, the substitute specification properly includes all portions of the application as filed. Furthermore, there is not requirement that a marked-up copy be submitted. However, even if this were a filing under 37 CFR §1.125(), there would be no need for a mark-up, since no changes to the specification text or figures have been made in the substitute specification (i.e. only the margins have been changed as requested in the Notice to File Missing Parts of Nonprovisional Application, dated June 4, 2001).

This application is a Rule 53(b) continuation of then pending Application Serial Number 09/749,596, filed December 28, 2000, and includes inventors named in the parent '596 application (See Request Form for Filing a Continuation Application Under 37 CFR §1.53(b), filed May 8, 2001; USPTO Filing Receipt, issued June 4, 2001; and Updated Filing Receipt, issued September 13, 2001). Hence, priority to December 28,

2000 was requested at the time of filing the present application in compliance with 37 CFR §1.78(a)(1).

Furthermore, the Request Form (see item 7 on page 2) explicitly amends the specification of the parent '596 application by inserting, before the first line of the application, "This application is a continuation of pending Application Serial No. 09/749,596 filed December 28, 2000", in compliance with the requirements of 37 CFR §1.78(a)(2).

Thus, all of the issues raised by the Examiner in paragraph 4 of the Official Action to which this response relates, were expressly addressed in the Request Form submitted at the time of filing the present application.

Accordingly, it is respectfully requested that the denial of entry of the substitute specification submitted with the Amendment filed on November 25, 2002, and the request for a further request for priority and further amendment to add a reference to the parent application, be reconsidered and withdrawn. It is also requested that the substitute specification be entered, and that the prior amendment to the present application inserting a reference to the parent application and the priority date to December 28, 2000 be acknowledged.

It is perhaps worthwhile to again note that the Request Form (see page 2, item 1b) deletes Tim Herdklotz and Cheryl Ward, who are inventors named in the parent '596 application, from the present application. Accordingly, the inventors in the present application are limited to Messrs. Ganesan, Renshaw and Kight, all of whom are also named inventors in the parent '596 application.

Claims 58-61 and 69-72 now stand rejected under 35 U.S.C. §102(e) as

anticipated by Van Dusen (U.S. Patent No. 6,175,823). Claims 58, 66-69, 71-73, 75 and 77-80 now stand rejected under 35 U.S.C. §103(a) as obvious over Van Dusen in view of the Lenhart publication (Lenhart, J. "'Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity," the Washington Post (December 20, 1998)). Claims 59-62, 64 and 70 now stand rejected under 35 U.S.C. §103(a) as obvious over the Van Dusen/Lenhart combination in further view of the Hansell publication (Hansell, S. "Electronic Checks to Pay Bills Over the Computer," the New York Times, August 27, 1995). Claims 63 and 74 stand rejected under 35 U.S.C. §103(a) as obvious over the Van Dusen/Lenhart combination in further view of the "WishClick" publication in Business Wire. Claims 65 and 76 stand rejected under 35 U.S.C. §103(a) as obvious over the Van Dusen/Lenhart combination in further view of Solokl et al. (U.S. Patent No. 6,173,269). The rejections are respectfully traversed.

No rejection has been asserted against claim 81. Claim 81 is accordingly presumed to be allowed and acknowledgement of same in the next Official Action is respectfully requested.

The arguments previously presented in traversal of prior rejections based on the prior art applied in the Official Action to which this response relates, are hereby reasserted in their entirety herein by reference.

Anticipation Rejection of Claims 58-61 and 69-72 by Van Dusen.

It is noted that the Examiner, in a prior Official Action, acknowledged that claims 58, 60-61, 69 and 71-72 incorporate features not disclosed in Van Dusen. Accordingly, the currently asserted rejection of these claims as anticipated 35 U.S.C. §102(e) by Van

Dusen is inconsistent with the Examiner's prior acknowledgement.

In any event, independent claim 58, from which claims 59-61 depend, requires *inter alia* that (1) a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, be received via a network; (2) the received request be processed to generate the electronic greeting card including a notification of the monetary gift; and (3) the generated electronic greeting card be transmitted, via the network, to the designated recipient.

Independent claim 69, from which claims 70-72 depend, requires, *inter alia*, (1) a communications port configured to receive a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, via a network, and (2) a processor configured to process the received request to generate the electronic greeting card including a notification of the monetary gift. Also required is that the communications port be further configured to transmit the electronic greeting card to the designated recipient via the network, and that the processor be further configured to direct funds equal to the monetary gift amount to be credited to a deposit account.

The phrase "electronic greeting card(s)" is well understood in the art. Exemplary electronic greeting cards are currently available at numerous Web sites, many of which have been in operation now for many years. With the availability of electronic greeting cards such as birthday, wedding, graduation, holiday, congratulatory and other type greeting cards.

In a prior Official Action, the Examiner correctly acknowledged that Van Dusen

does not disclose the generation of an electronic greeting card including a notification of a monetary gift or the transmission of such an electronic greeting card to the recipient. As pointed out in prior traversal arguments, Van Dusen lacks any teaching or suggestion that the gift certificates which Van Dusen discloses, should or could be requested in association with a request to send an electronic greeting card. Indeed, Van Dusen lacks of any disclosure whatsoever regarding greeting cards.

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. Anticipation requires that the claim under attack "read on" something disclosed in the reference. All limitations of the claim must be found in the reference, or "fully met" by it. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Hence, in view of the Examiner's own prior acknowledgement, the rejected claims cannot be anticipated by Van Dusen.

In this most recent action, the Examiner cites the abstract, and the disclosure in column 2, lines 58-64, column 3, lines 37-67, column 4, lines 33-54, and column 5, lines 1-10 of Van Dusen as teaching all the required features of claims 58-61 and 69-72. However, no analysis or rationale as to how the disclosure in these sections of Van Dusen anticipate the rejected claims is provided.

Contrary to the Examiner's assertions, the relied upon sections of Van Dusen do not even mention greeting cards, let alone electronic greeting cards. So it is entirely unclear how what is disclosed by Van Dusen in these sections could possibly anticipate the independent claims 58 and 69.

Claim 59 requires, *inter alia*, that the electronic greeting card be transmitted to the designated recipient at one of 1) a time subsequent to the directing of the crediting of the funds to the deposit account, and 2) a time concurrent with the directing of the crediting of the funds to the deposit account.

Claim 70 requires, *inter alia*, that the processor be further configured to cause the electronic greeting card to be transmitted to the recipient at one of 1) a time subsequent to the directing of the crediting of the funds to the deposit account, and 2) a time concurrent with the directing of the crediting of the funds to the deposit account.

Since Van Dusen lacks an electronic greeting card, it necessary also lacks the features and limitations recited in these claims. Furthermore, as explicitly disclosed in the Examiner referenced text in columns 3 and 4, Van Dusen always transmits the gift certificate email document to the recipient at a time prior to the directing of the crediting of the funds to the deposit account. Thus, the Examiner referenced text contradicts the Examiner's own contention. Furthermore, latter in the Official Action the Examiner expressly acknowledges that Van Dusen lacks the required limitations.

Claim 60 requires, *inter alia*, that the funds be directed to be credited to the deposit account at a financial institution.

Claim 71 requires, *inter alia*, that the processor be further configured to direct the funds to be credited to a deposit account at a financial institute.

To the extent Van Dusen can be construed to disclose a deposit of funds, as explicitly disclosed in the Examiner referenced text in column 4, in Van Dusen the amount shown on the gift certificate is always directed to be credited to an account at a merchant (e.g. Amazon.com), not a financial institution. Thus, here again, the Examiner references text

which contradicts the Examiner's own position.

For these and other reasons which are not detailed here, it is respectfully requested that the anticipation rejection of claims 58-61 and 69-72 be reconsidered and withdrawn.

Obviousness Rejection of claims 58, 66-69, 71-73, 75 and 77-80 over Van Dusen in view of the Lenhart publication

As discussed above, independent claim 58, from which claims 66-68 depend requires *inter alia* that (1) a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, be received via a network; (2) the received request be processed to generate the electronic greeting card including a notification of the monetary gift; and (3) the generated electronic greeting card be transmitted, via the network, to the designated recipient.

Independent claim 69, from which claims 71-73, 75, and 77-79 depend, requires *inter alia* (1) a communications port configured to receive a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, via a network, and (2) a processor configured to process the received request to generate the electronic greeting card including a notification of the monetary gift. Also required is that the communications port be further configured to transmit the electronic greeting card to the designated recipient via the network, and that the processor be further configured to direct funds equal to the monetary gift amount to be credited to a deposit account.

Independent claim 80, requires, *inter alia*, stored computer programming configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to (1) receive a request to make a monetary gift on behalf of a requesting donor to a designated recipient, and send an associated electronic greeting card, (2) generate the electronic greeting card including a notification of the monetary gift, based on the received request, and (3) cause the electronic greeting card to be transmitted to the designated recipient.

It is perhaps worthwhile to again point out that simplicity and hindsight are not proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986)). Obviousness cannot be properly established by simply showing that each claimed element may be found somewhere in the prior art (See Hartness International, Inc. v Simplimatic Engineering Co. (2 USPQ 2d 1826 (Fed. Circ. 1987))). Furthermore, the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and In re Keller 208 USPQ 817 (CCPA 1981)). Without a suggestion of the invention in the prior art reference combination, there is no motivation to combine the references. If there is no suggestion or motivation to combine the references in the prior art itself, there is no basis for the combination. Reliance on common knowledge and/or common sense cannot be the basis of finding obviousness (See In re Lee 61 USPQ 2d 1430 (Fed. Circ.

2002)). In the absence of such a suggestion the basis for the rejection can only be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

Once again, the Examiner's attention is drawn to the fact that Van Dusen, in the relied upon disclosure in column 2, lines 55-67 (see page 9, line 1, of the Official Action), describes the processing of the notification of the gift which is sent to the recipient, not the processing of a received request to generate a notification of the gift certificate for transmission to the designated recipient.

As also discussed in response to a prior Official Action, there is nothing within the applied art combination which suggest the Examiner's proposed modification to Van Dusen to arrive at the invention claimed in the present application.

Van Dusen teaches processing a request for a gift certificate and transmitting the certificate to the recipient, and lacks any disclosure whatsoever which suggests that the gift certificates should or beneficial could be requested in association with a request to send an electronic greeting card. Lenhart simply discloses that electronic greeting cards have become ubiquitous.

Nothing in either reference suggests the marriage of gift certificates and electronic greeting cards. Indeed, Lenhart, which is focused primarily on the business aspects of electronic greeting cards (i.e. who is providing and using the service and why, rather than technical aspect i.e. how the service is provided) fails to even recognize that there might be some benefit in doing so. If the marriage of electronic gift certificates and electronic greeting cards were obvious, as the Examiner contends, would not one expect to find something in the prior art which at least recognizes that there might be some benefit in

doing so?

It is respectfully submitted that the only disclosure within this case that makes this obvious to the Examiner, is the present application disclosure itself. This is not a proper reconstruction using McLaughlin's hindsight reasoning based on what is explicitly or implicitly disclosed in the uncovered and applied prior art. Rather this is an improper reconstruction which can only be based on the present disclosure, since there is nothing explicitly or implicitly disclosed in the uncovered and applied prior art which would lead one to the Examiner asserted conclusion.

How Van Dusen could possibly be modified to meet the claim limitations remains entirely unclear, and is at best speculative. The Examiner does not even attempt to explain how one might go about modifying Van Dusen in view of Lenhart to obtain the claimed invention. It is respectfully submitted that it is only through the efforts and expertise of the present inventors that the combination of monetary gifts and electronic greeting cards has been disclosed.

The Examiner alleges, without pointing to any support within the applied prior art, that "it would have been obvious...to modify Van Dusen to include the teaching of Lenhart because including the steps of receiving via a network, an input associated with an electronic greeting card, processing the donor's request and input to generate the electronic greeting card and transmitting, via a network, the electronic greeting card to the recipient would enable the donor to provide the recipient with a personalized greeting card along with the monetary gift" (emphasis added). This is what the present application discloses and the claimed invention accomplishes, but is not what is suggested in the prior art.

In the response to the previously presented traversal arguments, the Examiner further argues that “[i]n the art of giving gifts, it is customary to provide a card in association with a gift. In fact, the donor and recipient of a gift exchange are typically identified by a greeting card”.

However, it is respectfully submitted that the present invention is not in the art of traditional giving gift giving, but rather in the art of electronic monetary gifts and electronic greeting cards. It is acknowledged that it is well known to traditionally give a paper greeting card with a monetary gift inside. However, prior to the present invention, there is nothing that the Examiner has identified or pointed to which would suggest that anyone had determined how this could be applied to the electronic world, or even recognized that it might be beneficial to attempt to do so.

The Examiner further asserts that “[t]hus, by disclosing a system for delivering electronic gift certificates, Van Dusen suggests combining its teachings with the delivery of a greeting card as taught by Lenhart.

The basis for the asserted conclusion is entirely unsupported and cannot be understood. How can the disclosure of a system for delivering electronic gift certificates, which does not in anyway discuss greeting cards, or anything corresponding thereto, (i.e. the Van Dusen system disclosure) suggest that the disclosed system ought to be combined with art relating to the delivery of a greeting card? Without the recognition of some advantage for doing so, the combination would only serve to make the system more complex.

The Examiner further asserts that “[s]uch a combination would provide a friendly and amusing environment for the notification of a gift”.

How would one know, since it is entirely unclear as to how one would even go about modifying Van Dusen to add delivery of a greeting card, or if this could be done. The Examiner's assertion can only be based on the present disclosure or pure speculation. As noted above, obviousness cannot be properly established by simply showing that each element existed somewhere in the prior art. Furthermore, the mere possibility that the prior art could be modified to result in the claimed invention does not make it obvious to do so unless the prior art suggests the desirability of the modification.

The Examiner has failed to identify anything, outside of the present disclosure, which suggests the claimed invention. Thus, the Examiner is again respectfully requested to identify where within the applied art it is suggested that Van Dusen could beneficially be modified to process a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, and to generate an electronic greeting card which includes a notification of the monetary gift. It is respectfully submitted that there is nothing in the applied prior to suggest such a modification.

Further, assuming for the sake of argument that one could somehow construe the applied art to provide the required motivation, the Examiner is again requested to identify where within the applied art it is suggested how one would go about modifying Van Dusen to process a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, and to generate the electronic greeting card which includes a notification of the monetary gift.

It is respectfully submitted that there is nothing in the applied prior to suggest

such how a modification could be made, even if one were somehow motivated to try. Thus, it is again requested that the Examiner explain how one would go about modifying Van Dusem to include “the steps of receiving via a network, an input associated with an electronic greeting card, processing the donor’s request and input to generate the electronic greeting card and transmitting, via a network, the electronic greeting card” as asserted by the Examiner.

In summary, independent claims 58, 69 and 80 clearly distinguish over the applied prior art. If the claimed invention is so obvious, surely the Examiner can uncover prior art which at least alludes to the benefit of marrying electronic greeting cards with a monetary gift as disclosed and claimed in the present invention, and which suggests how one might go about doing so. If not, the Examiner is respectfully requested to withdraw the rejection and allow the claims to issue.

In addition to the distinguishing aspects of the independent claims, other features recited in the dependent claims further distinguish over the applied prior art. For example:

Claims 66 and 77 require that the request to send an electronic greeting card and to make an associated monetary gift in an amount, be received from an electronic greeting card service.

In the Examiner’s response to previously submitted traversal arguments, the Examiner asserts that the amendment of claim 66 necessitated new grounds of rejection and accordingly that the prior traversal arguments are moot.

However, the same art combination continues to be applied in support of the rejection. Furthermore, the Examiner does not identify any disclosure within the applied

combination that suggests the express limitations of the claim (see page 9 of the Official Action). Rather, the Examiner summarily states that Lenhart discloses the limitations. Hence, there is no objective support provided for the rejection, and it cannot be understood.

Claims 67 and 78 require that the request to send an electronic greeting card and to make an associated monetary gift in an amount be received, that the received request be processed, and that the generated electronic greeting card be transmitted by an electronic greeting card service, and that the crediting of the funds be directed by a payment service provider.

In the Examiner's response to previously submitted traversal arguments, the Examiner asserts that the amendment of claim 67 necessitated new grounds of rejection and accordingly that the prior traversal arguments are moot.

However, the same art combination continues to be applied in support of the rejection. Furthermore, the Examiner again does not identify any disclosure within the applied combination that suggests the express limitations of the claim (see page 9 of the Official Action). Instead, the Examiner summarily states that Lenhart discloses the limitations. Hence, there is no objective support provided for the rejection, and it cannot be understood.

Claims 68 and 79 require that the generated electronic greeting card, including the notification of the monetary gift, be transmitted, via the network, to an electronic greeting card service. In claim 68 this transmission occurs prior to the greeting card, including the notification of the monetary gift, is transmitted to the designated recipient.

In support of the rejection of claim 68, the Examiner acknowledges Van Dusen's

lack of any disclosure of a greeting card service transmitting a greeting card, but proposes to modify Van Dusen based on Lenhart (page 1, paragraphs 2-3, and page 2, paragraph 4) to transmit an electronic greeting card, including the notification of the monetary gift, to an electronic greeting card service prior to the electronic greeting card being transmitted to the designated recipient.

The Examiner's rationale is still not understood. The referenced sections of Lenhart teach that the greeting card service directly receives the electronic greeting card selection and the personalized message from the requestor, but (contrary to the Examiner's assertions in paragraph 10 of the Official Action) never the greeting card itself, let alone a greeting card that includes a notification of the monetary gift. The Examiner's statements in paragraph 10, lines 5-9, are neither consistent with nor supported by any disclosure within Lenhart.

Claim 75 requires that a payment account, at a financial institute associated with the requesting donor, be debited after activation of a hyperlink included in the transmitted greeting card.

Van Dusen's disclosure in column 3, lines 55-63, explicitly teaches that the donor's account is debited prior to any notification of the gift being transmitted to the designated recipient. Furthermore, the Examiner expressly acknowledges (later in the Official Action) that the applied combination lacks this feature.

Obviousness rejection of claims 59-62, 64 and 70 over the Van Dusen/Lenhart combination in further view of the Hansell publication

Claims 59 and 70 require that the electronic greeting card notifying a designated

recipient of a monetary gift be transmitted either (i) subsequent to the processor directing the crediting of the funds to the deposit account of a recipient or (ii) concurrent therewith.

The Examiner acknowledges that the primary combination of Van Dusen and Lenhart fails to disclose such limitations. Accordingly, the Examiner proposes to further modify the base combination based on Hansell's teaching on page 1.

However, on page 1 Hansell (see abstracted highlights at top of article) specifically teaches that the recipient of the electronic check must deposit it at a bank by email. Hence, according to Hansell, the notice of a monetary gift to a designated recipient must be transmitted before directing the crediting of the funds to the deposit account of the recipient (and never subsequent to or concurrent with the directing of the crediting of the funds to the deposit account of a recipient).

Claims 64 requires (as does claim 75) that a payment account, at a financial institute associated with the requesting donor, be debited after activation of a hyperlink included in the transmitted greeting card.

The Examiner now proposes to modify the base combination in view of the teachings of Hansell to meet the claimed limitation.

However, Van Dusen's disclosure in column 3, lines 55-63, explicitly discloses that the donor's account is debited prior to any notification of the gift certificate being transmitted to the designated recipient. That is, Van Dusen teaches that the recipient should not be notified of the gift until after the debiting of the donor's account has been completed. Hence, Van Dusen actually teaches against the modification proposed by the Examiner. To make the modification would be inconsistent with Van Dusen's own teaching. Thus, the proposed modification is improper.

Obviousness rejection of claims 63 and 74 over the Van Dusen/Lenhart combination in further view of the "WishClick" publication in Business Wire, and of claims 65 and 76 over the Van Dusen/Lenhart combination in further view of Solokl

Claims 63 and 74 require the further transmission to a non-designated recipient, of the electronic greeting card, including the hyperlink and the notification of the monetary gift, which had been transmitted to the designated recipient.

As understood, in the Examiner's response to the prior traversal arguments, the Examiner is asserting that Wishclick's disclosure that the merchant's crediting of a monetary amount to an account of a registered customer because the customer registers another customer is equivalent to the required further transmission to a non-designated recipient, of the electronic greeting card which had been transmitted to the designated recipient.

The Examiner's position is not understood. Claims 63 and 74 require that the card and gift notification be sent to the originally designated recipient and then be sent to a non-designated recipient, so that the non-designated recipient can have the monetary gift credited to his/her account. How can Wishclick's disclosure be construed to suggest this requirement? The WishClick reference discloses nothing more than a gift to designated recipients who have registered others.

Claims 65 and 76 require that the received request to send an electronic greeting card and to make an associated monetary gift in an amount, be processed to determine if the designated recipient is a member of an enclosed community prior to processing the request to generate the electronic greeting card including the notification of the monetary

gift (emphasis added).

The Examiner proposes to modify the base combination in accordance with the teachings of Solokl in column 8, lines 34-54, to meet the required limitations. However, the referenced disclosure relates to a sign-up procedure before any request to make a monetary gift is received. Hence, is it unclear how the relied upon disclosure is relevant.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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